

## **REMARKS**

Entry of this Reply is proper under 37 C.F.R. § 1.116, because the Reply places the application in condition for allowance for the reasons discussed herein; does not present any additional claims; and places the application in better form for an appeal should an appeal be necessary. Entry of the Reply, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are thus respectfully requested.

### **1. Status of the Claims**

Claims 11-12, 14-16, 19-21 stand pending. Claims 1-10, 13, and 17-18 have been canceled.

### **2. Acknowledgement of the Claim for Priority**

Acknowledgement of receipt of the Certified Priority Documents by the Office is appreciated.

### **3. Double Patenting Rejection**

The rejection of the claims 11, 12, 14-16 and 19 is maintained over U.S. Patent Nos. 6,455,549 [hereinafter the '549 patent issued from U.S. Application No. 09/043,563] and 6,838,470 [hereinafter the '470 patent].

Applicants respectfully traverse and maintain that a *prima facie* case of nonstatutory double patenting has not been adduced between the claims of the instant application and the two patents.

In order for a *prima facie* case of double patenting to be found, the following steps must be carried out. As set forth in M.P.E.P. § 804, the analysis follows the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966):

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

Additionally, when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the patent disclosure of the patent may not be used as prior art. M.P.E.P. § 804.

Applicants amended the claims in the amendment and reply dated July 14, 2006. Yet, the instant Office Action does not perform the requisite analysis in view of the claim amendments. In fact, no analysis is made with regard to the claims. The Office only provides conclusions that the '470 patent claims are similar and obvious modifications of the instantly claimed subject matter. The Office fails to provide any analysis explaining why the instant claims fail to be independent and distinct from those of the '470 patent.

A similar argument is presented for the double patenting rejection as between U.S. Patent No. 6,455,549 and the instant claims. Again, the Office merely states "The parent claims were of different scope, however there is still overlapping subject matter." The Office provides no substantiating argumentation in view of the claim amendments to support its position. Therefore, Applicants assert that a *prima facie* case of nonstatutory obviousness type double patenting has not been adduced.

Applicants further point out that the Office Action must also be clearly developed to such an extent that an applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection. See M.P.E.P. § 706.07. No mention was made to the January 17, 2006 Office Action. Amendments were made to the claims in Applicants' reply filed July 14, 2006. Therefore, Applicants assert that no *prima facie* case of obviousness type double patenting has been set forth as to the claims currently pending, and therefore the finality of the rejection is premature and should be withdrawn.

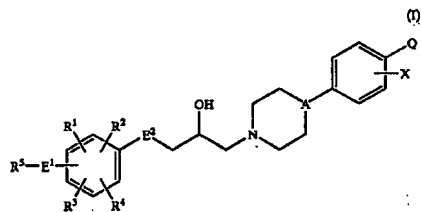
The Office has maintained that nonstatutory obviousness type double patenting exists over claims 1-10 the '549 patent and claims 11, 12, 14-16, and 19 of the instant application. As noted by the Office, the instant application is a divisional of U.S. Application No. 10/196,362, which in turn is a divisional of U.S. Application No. 09/043,563, now U.S. Patent No., 6,455,549. The claims of the instant application are directed to Group II of the restriction requirement which issued in the grandparent application, U.S. Application No. 09/043,563. The fact that there is an intervening application in the chain does not negate the prohibition of double patenting rejections under 35 U.S.C. § 121. See M.P.E.P. § 804.01. Divisional applications off the first filed parent application can be filed and have been filed at

any time as long as there is a pending application in chain. Consequently, Applicants submit, as previously asserted, that the claims of the instant application are directed to the subject matter of Group II as set forth in the restriction requirement that issued in the grandparent application. Group I claims which later issued from the '563 application. Applicants further note that the restriction requirement in the '563 application was not withdrawn, and continues to stand. Accordingly, the Office cannot now change its position with regard to that restriction.

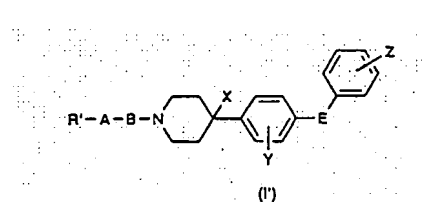
When claims are pursued and based on an involuntary divisional arising from restricted subject matter, the Office has a burden to evince that the claims are not consonant with a restriction requirement previously made by the Office. The Office must show that the claims have been changed in material respects such that the original restriction does not apply to the claims. No such argument has been presented to Applicants. Therefore, the rejection of claims 11, 12, 14-16 and 19 over U.S. Patent No. 6,455,549 is improper and should be withdrawn, or the Office should present its arguments in a subsequent non-final Office Action to which Applicants can respond.

Applicants assert that it would be improper to require a terminal disclaimer in the subject application in view of the restriction requirement presented in the grandparent case, to which the claims of the instant case are directed to independent and distinct subject matter.

The Office also rejected claims 11, 12, 14-16 and 19 over claims 1-10 of U.S. Patent No. 6,838,470 [hereinafter the '470 patent] as allegedly obvious under the nonstatutory double patenting standard. Applicants traverse the rejection. In addition to the arguments presented above regarding the lack of substantiation for the Office's position, Applicants present the following arguments. As previously pointed out in the July 14, 2006 response, the structure of formula (I') of the instant claims differs from formula (I) of the '470 patent. Namely, E<sup>2</sup> of the '470 patent is either O, S, or NR<sup>7</sup>. In the instant application, -A-B-, which corresponds to E<sup>2</sup> of formula (I) of the '470 patent, has A as a connecting bond and B as an alkylene. A side-by-side comparison of the structures is indicated below.



Formula (I) of '470 Patent



Formula (I') of instant application

The fact that A is a  $-C(OH)$  in the '470 patent, which is equivalent to position of X formula (I') of the instant case, is the same is irrelevant given the distinguishing differences described above. In the instant Office Action, the Office offers only the conclusion that the '470 patent "has similar and obvious modifications of the subject matter." No scientific reasoning is presented explaining let alone substantiating why claims 1-10 of the '470 patent are indistinct over the present claims. Accordingly, Applicants assert that a *prima facie* case of nonstatutory double patenting has not been adduced and that the finality of the rejection is premature.

The Office also provides information on homology quoting the case of *In re Druey*, 50 C.C.P.A. 1538, 319 F.2d 237, 138 U.S.P.Q. 39 (C.C.P.A. 1963). It is unclear from the record as to the context in which the case and quote are being applied to the instant application and claims.

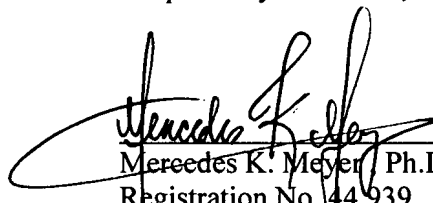
Finally, Applicants refer to M.P.E.P. § 804.02 II. "Nonstatutory," which indicates that the use of a terminal disclaimer in overcoming a non-statutory double patenting rejection is useful in handling the earlier filing of and earlier expiration of patents. Applicants point out that the instant application if issued, would expire prior to the expiration of the '470 patent. Thus, a terminal disclaimer is not warranted for this situation.

### **CONCLUSION**

In conclusion, this is believed to be in full response to the outstanding restriction requirement. Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to respectively charge or credit Deposit Account No. 50-0573. The Office is authorized to charge the Deposit Account for Notice of Appeal, if said Notice of Appeal is necessary in order to maintain pendency of the application.

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Respectfully submitted,



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